

## **REMARKS**

Applicant respectfully requests reconsideration of the present application based on the foregoing amendments and the following remarks. Applicant herein amends claim 34, cancels claims 41 and 42 and adds claims 48-56. Upon entry of this amendment, claims 34-40, 43-45 and 48 will be pending in the application.

### ***Amendments Entered After Final Office Action***

In response to the Final Office Action mailed October 31, 2005, Applicant filed an Amendment on January 3, 2006 in which claims 34 and 43 were amended, and claims 46-47 were canceled to address objections to claims 46 and 47 and Section 112 (first paragraph) rejections of claim 34 “and claims dependent thereupon.” In the Advisory Action mailed January 18, 2006, the Examiner indicated these amendments were entered “to remove 112, first paragraph issues, [and] claim objections.” Accordingly, this Amendment is based on the claims as pending after entry of the amendments mailed January 3, 2006.

### ***Emergency Contact Information***

The Final Office Action mailed Oct. 31, 2005 at page 8 states “the Examiner acknowledges that applicant restricts his invention to retrieving and transmitting a specific type of data, as above.” Thus it is assumed that the Examiner and Applicants are in agreement that the claims are specifically directed to retrieving and transmitting **emergency contact information**, as explicitly recited in the claims.

### ***Claim Rejections Under 35 U.S.C. 103 in view of Kennedy and Clifford***

In the Final Office Action, claims 34-36, 38-39, 43 and 45-47 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,535,743 to Kennedy III et al. (“Kennedy”) in view of “Clifford enters telematics with net-based car PC,” TWICE Vol. 15, Iss. 3, p. 40 (Jan. 24, 2000) (“Clifford”). Claims 46 and 47 have been canceled, rendering the rejections thereof moot.

Moreover, claim 34, which is the only rejected independent claim, has been amended to incorporate subject matter of former dependent claims 41 and 42, which were previously rejected for other reasons addressed below. Accordingly, this rejection has been rendered moot.

***Claim Rejections Under 35 U.S.C. 103 in view of Kennedy and InfoGation***

In the Final Office Action, claim 37 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of “InfoGation Corp. Introduces Productivity, Navigation, Safety and Communication Software Applications for Next-Generation Smart Car Systems,” PR Newswire, Jan. 8, 1998 (“InfoGation”).

Claim 37 depends from independent claim 34, which has been amended to incorporate subject matter from claims 41 and 42, which were previously rejected for other reasons addressed below. Accordingly, this rejection has been rendered moot.

***Claim Rejections Under 35 U.S.C. 103 in view of Kennedy and Suman***

In the Final Office Action, claim 40 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of U.S. Patent No. 6,028,537 to Suman et al. (“Suman”). For reasons set forth more fully below, this rejection is respectfully traversed.

Claim 40 depends from independent claim 34, which has been amended to incorporate subject matter from claims 41 and 42, which were previously rejected for other reasons addressed below. Accordingly, this rejection has been rendered moot.

***Claim Rejections Under 35 U.S.C. 103 in view of Kennedy and Ford***

In the Final Office Action, claims 41-42 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of “Ford to Bring Internet to Millions of Vehicles,” PR Newswire, Jan. 9, 2000 (“Ford”). For reasons set forth more fully below, this rejection is respectfully traversed.

Claims 41-42 have been canceled, and much of the subject matter therein has been incorporated into independent claim 34, from which claim 44 also depends. In addition, claim 34 has been further amended, and now explicitly requires, *inter alia*:

**providing a site on the Internet that communicates with the server and that can be accessed by the customer independently from the telematics device so that the customer can specify the emergency contact information stored by the virtual garage and to be transmitted to the telematics device during the emergency;**

retrieving the emergency contact information of the customer from the virtual garage using the telematics device; and  
transmitting the retrieved emergency contact information of the customer from the telematics device embedded in the customer vehicle to the Public Safety Answering Point **so that the Public Safety Answering Point will have the customer's emergency contact information that was specified by the customer via the Internet site and retrieved from the virtual garage by the telematics device during the emergency.**

The Final Office Action admitted that Kennedy did not disclose the subject matter of claims 41 and 42, instead relying on Ford for meeting the above recited limitations.

However, Ford merely discloses a “voice-activated telematics system” that allows “voice-activated access to personalized Internet information.” Ford does not disclose or suggest at least:

- (1) storing or maintaining emergency contact information;
- (2) providing a site on the Internet whereby a customer can specify anything at all;
- (3) providing a site on the Internet that can be accessed by the customer independently of the telematics device;
- (4) transmitting anything at all to a PSAP from a telematics device embedded in a customer's vehicle; or
- (5) providing a PSAP emergency contact information of a customer during an emergency.

Ford merely states that “connected customers will be able to customize their Internet offerings so their favorite items will be delivered automatically.” This does not providing a teaching sufficient to enable practice of any of the above subject matter.

Applicant notes that Clifford, although not cited in connection with the rejection of claims 41 and 42, states that “users can preset the system (via an Internet website) to call their

cellphone, home or office for specific security breaches.” However, Clifford does not disclose or suggest at least:

- (1) storing or maintaining emergency contact information;
- (2) providing a site on the Internet whereby a customer can specify emergency contact information to be transmitted to a telematics device during an emergency;
- (3) transmitting anything at all to a PSAP from a telematics device embedded in a customer’s vehicle; or
- (4) providing a PSAP emergency contact information of a customer during an emergency

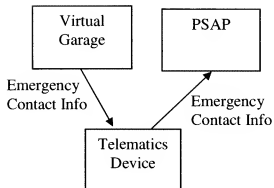
Accordingly, even if the Examiner alleged that Clifford could be combined with Kennedy and Ford, the above limitations would still not be taught or suggested.

***No Cited Prior Art Suggests Retrieving and Transmitting Emergency Contact Information From A Telematics Device To A PSAP***

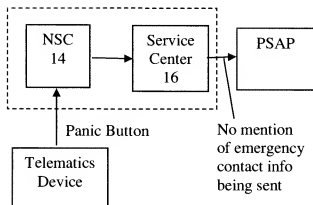
Independent claim 34 clearly requires “transmitting the retrieved emergency contact information of the customer from the telematics device embedded in the customer vehicle to the Public Safety Answering point so that the Public Safety Answering Point will have the customer’s emergency contact information that was specified by the customer via the Internet site and retrieved from the virtual garage by the telematics device during the emergency.”

The Examiner’s previous Office Actions have relied on Kennedy and Clifford as allegedly meeting these limitations. However, the following diagram graphically illustrates the critical differences between the explicit claim limitations and the cited prior art:

Claim 34



Kennedy / Clifford



In summary, the claims require emergency contact information to be retrieved by the telematics device and transmitted from the telematics device to a PSAP during an emergency. On the other hand, Kennedy requires a NSC 14 to transmit information to an “appropriate” service center 16, and the service center 16 then transmits information to a PSAP. Clifford mentions only a single “call center” (as indicated by the dotted-line box), which relays information to a PSAP. Moreover, in neither event does Kennedy or Clifford disclose providing emergency contact information to a PSAP.

Kennedy Does Not Teach Transmitting Any Information From A Telematics Device To A PSAP

The Office Action does not even allege that Clifford discloses transmitting anything from a telematics device to a PSAP, instead relying solely on Kennedy for this subject matter.

However, Kennedy does not disclose or suggest that mobile unit 12 (the alleged telematics device) can transmit anything at all to a PSAP, much less the emergency contact information that is also not disclosed by Kennedy. Instead, Kennedy merely discloses that in certain “operations,” the mobile unit 12 can exchange data with a service center 16. (note that even at col. 13, lines 1-20, Kennedy does not explicitly mention that unit 12 can send any data to service center 16, except perhaps menu selections on a user interface 24).

However, during an emergency, Kennedy explicitly requires the service center 16 (i.e. not the mobile unit 12), to contact emergency personnel and to provide information about the vehicle to them. As set forth in column 15, lines 35-44, Kennedy teaches that, in response to an

“emergency assistance button” being pressed: “NSC 14 then provides to the appropriate service center 16 a precise vehicle location and previous travel direction of mobile unit 12, as well as the color, make, model, and license number of the vehicle associated with mobile unit 12. Service center 16 may then effectively dispatch personnel to assist the operator of mobile unit 12.”

Moreover, Kennedy teaches that service center 16 is comprised of servers, “personnel, businesses, or any other suitable provider of enhanced services.” (col. 9, lines 15-16). Kennedy does not explicitly mention that personnel in service center 16 must call 911 or other services (i.e. use manual steps and intervention) to render emergency assistance, but that is the most likely scenario, and in any event, Kennedy does not explicitly disclose any other scenarios.

#### Neither Kennedy Nor Clifford Teaches Retrieving Emergency Contact Information Using A Telematics Device

The Office Action admits that Kennedy does not disclose retrieving emergency contact information using a telematics device, and relies on Clifford for this subject matter instead. As set forth above, Clifford does not suggest transmitting anything from a telematics device to a PSAP, as the Examiner admits. Moreover, as set forth below, Clifford does not suggest retrieving any information during an emergency using a telematics device.

Clifford merely teaches a “telematics product called the MobileTrace 1” that is essentially a black box with built-in GPS and modem. The MobileTrace 1 has a “panic button.” When pressed, the box contacts a live call center and provides the vehicle location. In addition, the call center has a user profile of the driver, and the call center can notify police, a hospital and a doctor.

Clifford merely discloses that the personal profile information includes a person’s heart condition. It does not explicitly disclose storing emergency contact information. However, since the one sentence in Clifford including “your hospital and doctor” is ambiguous, Applicant will not address this lack of teaching for the sake of argument.<sup>1</sup>

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<sup>1</sup> Kennedy also merely discloses that NSC 14 / service center 16 can provide emergency services with “relevant medical information about the operator of mobile unit 12” and “personal medical data.” col. 15, lines 7-19. Applicant maintains that this does not suggest providing emergency contact information.

In any event, nowhere does Clifford teach the explicit step of **retrieving the emergency contact information of the customer from the virtual garage using the telematics device**. Rather, Clifford clearly requires the call center to provide information to emergency services, and so it is completely unnecessary for the black box to retrieve this information. Similarly, Kennedy requires a service center 16 to provide information to emergency services. Accordingly, the alleged combination of Kennedy and Clifford requires supplying information from a call center or service center to emergency services, and so the alleged combination **teaches away** from **retrieving emergency contact information using a telematics device** because it would be completely unnecessary.

Accordingly, only hindsight reconstruction of Applicant's invention would render the subject matter of the claims obvious, and the operations and teachings **of the references themselves** would have taught away from the invention.

**Retrieving Emergency Contact Information, and Transmitting This To A PSAP Using A Telematics Device Is A Non-Obvious Change Of Kennedy And Clifford**

Even though the Examiner fails to establish a **prima facie** case of obviousness, Applicant further addresses reasons why the alleged combination of Kennedy and Clifford would not have suggested the invention as claimed in independent claim 34.

Importantly, further modifications would be required to the alleged combination of Kennedy and Clifford to allow a telematics device to retrieve emergency contact information and transmit this to a PSAP. Apparently, the Examiner takes the position that this further modification would be obvious because "a customer may wish to have his doctor be alerted that an emergency has taken place that may require the doctor's service." Applicant respectfully disagrees with this position.

First, Clifford already discloses a system in which a **call center** allows a "doctor to be alerted that an emergency has taken place." Accordingly, the Examiner's alleged motivation to change Clifford is contradicted by Clifford itself, which renders it **unnecessary** for a telematics device to retrieve and transmit doctor information (i.e. the call center already has this information and allegedly uses it to notify a doctor).

Moreover, further contrary to the Office Action, it is not obvious to supply contact information **from a telematics device to a PSAP**, as is further explicitly required by the claims and not taught or suggested by either Kennedy or Clifford. As repeatedly demonstrated by the Examiner's cited prior art, all previous systems rely on a call center to call and provide information to a PSAP. Accordingly, the prior art is filled with multiple teachings **away** from the requirements of the claims.

### ***The Invention Of Claim 34 Satisfies A Long-Felt Need Not Solved By Others***

Previous Office Actions have apparently taken the position that, although no prior art explicitly teaches providing a PSAP with emergency contact information during an emergency from a vehicle, that such an improvement would be obvious because other types of information are relayed to a PSAP using other mechanisms.

However, as set forth in the accompanying Declaration of Lawrence Williams, providing emergency contact information to a PSAP has been a long-felt need that has not been satisfied by others, whereas the invention satisfies this need.

In particular, in compliance with MPEP 716.04, the attached Declaration provides objective evidence that:

- Providing emergency contact information to a PSAP during an emergency is a long-felt need in the art;
- As of 2005, more than five years after the present invention, this long-felt need had not been satisfied by others; and
- The invention as claimed satisfies this long-felt need.

The Examiner must consider this Declaration under MPEP 716 and the associated evidence of non-obviousness.

### ***The Invention Of Claim 34 Has Enjoyed Commercial Success***

As further set forth in the accompanying Declaration of Lawrence Williams, the claimed invention of providing emergency contact information to a PSAP from a vehicle has enjoyed commercial success.



In particular, in compliance with MPEP 716.03, the attached Declaration provides objective evidence that:

- A system for providing emergency contact information to a PSAP during an emergency was employed in a Safety Pilot program for the Greater Harris County Emergency 9-1-1 Network in 2002 and 2003, which network is one of the largest 911 networks in the United States;
- The Safety Pilot program was awarded the 2004 Telematics in Action Award from Telematics Update magazine; and
- The Award recognizes development and deployment of telematics for the enhancement of emergency response and driver safety; and
- The enhancement of emergency response and driver safety in the Safety Pilot program was made possible by the claimed invention's ability to rapidly and accurately a driver's personal medical data, including emergency contact information.

The Examiner must consider this Declaration under MPEP 716 and the associated evidence of non-obviousness.

#### ***Newly Added Claims***

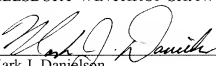
Claims 48-56 have been added to further set forth patentable features that are fully supported by the original specification. See, for example, page 5, lines 10-16, page 8, line 19 to page 9, line 11, page 12, lines 12-20, page 15, line 19 to page 16, line 4, and page 18, lines 13-20.

***Conclusion***

All objections and rejections having been addressed, and in view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. If any issues remain which the Examiner feels may be resolved through a telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
PILLSBURY WINTHROP SHAW PITTMAN LLP

Date: March 29, 2006



Mark J. Danjelson  
(650) 233-4777

40,580

Reg. No.

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